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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,863	01/03/2001	Bruce D. Melick	P04337US1	1777

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MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER
TREMBLAY, MARK STEPHEN

ART UNIT	PAPER NUMBER
2876	8

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/753,863	MELICK ET AL.	
	Examiner	Art Unit	
	Mark Tremblay	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-12,14-16 and 18-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-12,14-16 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-12, 14-16 and 18-20, are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,579,537 to Takahisa ("Takahisa" hereinafter), figure 13 and description thereof. Takahisa disclosed the use of scanners, but did not disclose a scanner which scans at 100 scans per second or greater. Applicant has admitted that such scanners existed commercially at the time the invention was made. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use high scan rate scanners in Takahisa because high scan rate scanners existed commercially at the time the invention was made as admitted by Applicant. Since Takahisa did not specify which type of scanner to use, it would have been obvious to use all commercially available scanners, including high rate scanners. If a scanner did not work in the Takahisa invention, it would be obvious to substitute another commercially available scanner, until one was found that worked.

Alternatively, Examiner finds that persons having ordinary skill in the art would recognize the conflict between a low scan rate scanner and the refresh rate of computer monitors. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a high rate scanner in the Takahisa invention because known

monitor refresh rates were typically from 60 to 85 cycles per second. If a scanner scanned at or near these rates, it would be unable to get a complete bar code scan before the display changed. This would be obvious from the specifications of the monitor and the specifications of commercial bar code readers.

Re claims 4-8, 11-12, 15, and 19-20, Official Notice is taken that the Internet is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to substitute transmission over the airwaves in Takahisa for transmission using various components of the Internet because the Internet became a standard for disseminating information.

Remarks

Examiner's job is to examine patent applications, not experiment with PTO supplied equipment. Examiner's workstation is locked, and the Welch Allyn scanner supplied with the workstations is off limits to tampering. Although the Examiner would have found it convenient to scan codes from the screen, Examiner did not pursue the matter when it was found not to work with the supplied equipment. Examiner would have spent much more time trying to change the PTO system than examiner would have saved by scanning codes from the screen. Examiner has not investigated the operating settings of the Welch Allyn scanner, but believes the legacy PALM system requires compatibility with the laser scanners previously used.

Thus, if the workstation failed to read bar codes, it was not Examiner's line of work to correct this. On the other hand, it would be the job of a person having ordinary skill in the art seeking to implement a system according to Takahisa.

Examiner does not agree with Applicant's assertion that Takahisa is inoperative. Takahisa is presumed operative until it is proved otherwise, since Takihisa is silent on the scan rate, but commercial scanners having sufficient scan rates existed at the time, there is no basis to conclude that Takahisa is inoperative or not enabling.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is

available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

MARK TREMBLAY
PRIMARY EXAMINER

December 16, 2002